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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,886	12/05/2001	Richard Ford	296/1	7948
27538	7590	06/21/2005	EXAMINER	
KAPLAN & GILMAN , L.L.P. 900 ROUTE 9 NORTH WOODBIDGE, NJ 07095			PICH, PONNOREAY	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/005,886

Applicant(s)

FORD ET AL.

Examiner

Ponnoreay Pich

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-12 have been examined and are pending.

#### ***Priority***

The examiner acknowledges applicant's claim to priority date 10/16/2001.

#### ***Specification***

1. The abstract of the disclosure is objected to because in line 8, the examiner believes applicant mean to recite "In" instead of "If". Correction is required. See MPEP § 608.01(b).
2. The use of the trademark "REVERSE FIREWALL", "Cs3", "NETWORK ICE CORPORATION", and "BLACKICE GUARD" have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The disclosure is objected to because of the following informalities: On page 8, line 7, the examiner believes applicant mean to refer to Figure 5 instead of Figure 4.

Appropriate correction is required.

#### ***Claim Rejections – 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al (US 6,701,440).

**Claim 1:**

Kim discloses a method for the containment of a virus in a computer network, comprising evaluating an outgoing message from a computer device and blocking the transmission of the message if it does not conform to an established list of permitted actions (col 5, lines 56-64 and col 6, lines 48-64). The permitted actions are that the messages are virus free and the sender is not on a block list.

**Claim 7:**

Kim discloses a firewall system for the containment of a virus in a computer network, comprising a firewall, i.e. e-mail virus-detection system 100, for receiving a message from a computer device, comparing the received message to an established list of permitted operations and transmitting the received message only if it conforms to the list of operations (col 5, lines 56-64 and col 6, lines 48-64).

Claims 2-3, 6, and 8-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Daniely (US 6,763,469).

**Claim 2:**

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Daniely discloses a method for the containment of a virus in a computer network, comprising:

1. Establishing a list of permitted operations in a computer network (col 2, line 44-col 3, line 8 and col 4, lines 9-12).
2. Intercepting a message emanating from a device in the computer network (col 5, liens 26-34).
3. Comparing the intercepted message to the list of permitted operations (col 5, lines 12-18 and 35-40 and col 5, line 50-col 6, line 2).
4. Transmitting the message if the message conforms to one of the permitted operations on the list (col 4, lines 44-52).
5. Blocking the message if the message does not conform to one of the permitted operations on the list (col 4, liens 44-52).

**Claim 3:**

Daniely further discloses wherein the list of permitted operations comprises permitting transmission only to another network or computer device having one of a certain addresses or protocols (col 5, lines 13-18).

**Claim 6:**

Daniely further discloses comprising transmitting the message only if the message conforms to a first and a second of the permitted operations on the list (col 5, lines 13-18). The first and second permitted operations correspond to permitted addresses and permitted protocols respectively.

**Claim 8:**

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Daniely discloses a firedoor system for the containment of a virus in a computer network, comprising:

1. A firewall connected to the computer so as to receive messages from an outside source and adapted for screening unwanted messages (col 1, lines 31-36; col 5, lines 26-36 and 13-18; and Fig 1A, item 16).
2. A computer device connected to receive messages passed by the firewall (Fig 1A, items 22, 24, and 28).
3. A firedoor connected to the computer device so as to receive messages from the computer device and to evaluate the received messages and transmit only permitted messages to other computer devices in the network (Fig 1A, item 20).

**Claim 9:**

Daniely further discloses wherein the firedoor is connected to an output port of the computer device (col 4, lines 53-67).

**Claim 10:**

Daniely further discloses wherein the firedoor is connected to a computer network bus (col 4, lines 53-67).

**Claim 11:**

Daniely further discloses wherein the firedoor is connected to a computer network channel (col 4, lines 53-67 and Fig 1A).

**Claim 12:**

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Daniely further discloses wherein the firedoor is provided in series with a second firedoor so that different verification criteria from each firedoor are applied serially (Fig 1A).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniely (US 6,763,469) in view of Baehr et al (US 5,802,320).

#### **Claim 4:**

Daniely does not explicitly disclose wherein the list of permitted operations comprises transmission to another network or computer device only in response to an external initiation. However, Baehr discloses screening rules according to services (such as FTP or email) which are allowed or not allowed (col 1, lines 6-11 and col 6, line 58-col 7, line 5). It is obvious that a computer or server running an FTP service can only start an FTP transfer if the FTP request was initiated externally as an FTP server cannot just connect to a random client and initiate transfer itself.

In light of this, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Daniely's invention according

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to the limitations recited in claim 4. One of ordinary skill would have been motivated to do so as Baehr discloses that it is sometimes desirable to allow only certain types of connections in a network (col 8, lines 56-61).

**Claim 5:**

Daniely does not explicitly disclose wherein one of the permitted operations comprises establishing communications between two servers or the like devices. However, Baehr discloses screening rules according to services (such as FTP or email) which are allowed or not allowed (col 1, lines 6-11 and col 6, line 58-col 7, line 5). When an email is sent, the sending server connects to a receiving server. Therefore, Baehr makes the above limitations obvious.

In light of this, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Daniely's invention according to the limitations recited in claim 5. One of ordinary skill would have been motivated to do so as Baehr discloses that it is sometimes desirable to allow only certain types of connections in a network (col 8, lines 56-61).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 8:00am-4:30pm Mon-Fri.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PP

  
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